

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI

OPINIONS OF THE COURTS BELOW

No formal opinion was rendered by the District Court. His remarks from the bench are reported beginning at Page 757 of Volume II of the record.

The opinion of the Circuit Court of Appeals for the Sixth Circuit is reported in 152 Fed. (2d) 203.

JURISDICTION

The grounds for jurisdiction are:

1. The date of the judgment to be reviewed is December 13, 1942.

2. The judgment was rendered in a civil action brought under the patent statutes to determine issues of validity and infringement of Letters Patent for invention.

3. The statute under which jurisdiction is invoked is 240 (a) of the Judicial Code, 28 U.S.C.A. 347, as amended by the Act of February 13, 1925.

4. Cases believed to sustain the jurisdiction are:

Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47;

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U.S. 464;

Altoona Publix Theaters v. American Tri-Ergon Corp., 294 U.S. 477;

Muncie Gear Works, Inc., et al vs. Outboard, Marine & Manufacturing Company, et al, 315 U.S. 759.

STATEMENT

The facts are sufficiently stated in the Petition.

SPECIFICATION OF ERRORS

If the Petition for Certiorari is granted, Petitioner will urge that the Circuit Court of Appeals for the Sixth Circuit erred:

1. In sustaining the validity of Drachenberg patent 2,273,093.
2. In failing to hold void each of claims 6, 7, 8, 9 and 15 in suit as wanting in invention, and covering merely exhausted combinations, and being directed to unpatentable aggregations of elements selected from the prior art.

SUMMARY OF ARGUMENT

I. The decision below leaves the Drachenberg patent dominating an industry, with no likelihood that there will ever be opportunity for further challenge of its validity.

II. It is not invention merely to select and aggregate unrelated features taken from prior art.

III. Aggregation is demonstrated by supplying the claims.

IV. The claims at issue do not include the structure upon which Drachenberg's alleged commercial success is based.

V. The claims at issue seek to re-patent an old combination by reclaiming it with a substituted element.

POINT I

By the decision below, the Drachenberg patent is left in domination and control of an entire industry, without further opportunity for challenging the validity of this patent being likely. The Circuit Court of Appeals for the Sixth Circuit found in the opinion below:

"Plaintiff's expert stated that although he had made inquiries, he had been unable to find any other machines of this kind on the market except those involved in this case."

If Petitioner is eliminated, Respondent will be left with a wholly illegal monopoly couched in terms of a combination conclusively shown to be old, and depending for its alleged novelty upon selection and aggregation of unrelated features from expired art.

The quotation in the Petition from the trade paper "Health Food Retailer" shows that the trade regards the opinion below as having conferred upon Respondent Drachenberg exclusive rights covering the centrifugal type of extractor. Such in fact appears to be the effect of the opinion below.

In the case of *Schriber Schroth vs. Cleveland*, 305 U.S. 47 at page 50, this Court said:

"Notwithstanding the doubtful validity of the patent, litigation elsewhere with a resulting conflict of decision is improbable because of the concentration of the . . . industry."

In the present case, the industry is not merely concentrated in one circuit,—it is concentrated in the hands of one individual, save only for the negligible operations of one other man on the west coast which do not appear to have been sufficient to have attracted the attention of the Circuit Court of Appeals for the Sixth Circuit.

Certiorari was granted on the same grounds in the case of Muncie Gear Works vs. Outboard, Marine & Manufacturing Company, the memorandum order being found in 315 U.S. 100 and the opinion of the court on the merits in 315 U.S. 759.

POINT II

It is not invention merely to select and aggregate unrelated features taken from the prior art.

In *Toledo Pressed Steel Company vs. Standard Parts, Inc.*, 307 U.S. 350, 355, this Court said:

"The torch body was old in the art to which it belonged. The cap, as part of devices used in other fields, was old and useful to prevent extinguishment of flames by wind or rain and to permit flames to extend through holes to the open air. The problem patentees set for themselves was to prevent extinguishment while preserving usefulness of the flames as warning signals. They solved it by merely bringing together the torch and cap. As before, the torch continued to produce a luminescent, undulating flame, and the cap continued to let in air for combustion, to protect the flame from wind and rain and to allow it to emerge as a warning signal. They performed no joint function. Each served as separately it had done. The patented device results from mere aggregation of two old devices, and not from invention or discovery. *Hailes v. Van Wormer*, 20 Wall. 353, 368. *Reckendorfer v. Faber*, 92 U.S. 347, 357; *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549-50."

POINT III

That the claims at issue do call merely for the aggregation of features old in the art is demonstrated by applying any one of them to the composite structure shown by



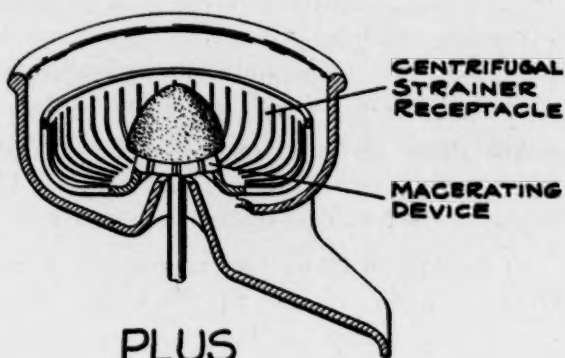
Petitioner's cut herewith again reproduced. Typical claim 7 reads as follows:

"7. "A device of the class described, comprising: a rotatable body rotatable on an axially directed axis; a wall embracing said body, said wall being perforated; a stationary chute projected inwardly of said wall and overlying said body and spaced therefrom at one end, said end being open for depositing materials on said body; macerating means on the upper face of said body for, upon rotation thereof, engaging and macerating materials projecting beyond the end of said chute and carrying the same clear of said chute and projecting the same against the said wall, the open end of said chute being of less area than the area defined by said macerating means during rotation; means for rotating said body and said wall in unison; and a housing enclosing said wall for receiving juices passing there-through."

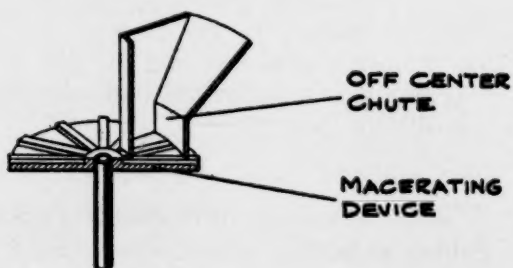
The foregoing claim derives from Steere the rotatable body, the macerating means on the upper face thereof, and the stationary chute of less area beneath which the macerating means rotates to engage and macerate material and project it clear of the chute. From Brophy the claimed subject matter takes the perforate wall embracing the body and into which the chute extends, such wall comprising Brophy's centrifugal strainer receptacle. The shaft and motor of Brophy rotate the macerating disk and wall in unison and the housing encircling Brophy's centrifugal strainer receptacle is adapted to receive the juices passing through the receptacle.

Claim 9 is one of the claims which specifies the eccentric location of the chute. The base of the receptacle is the hub to which the motor shaft is attached as shown in Brophy. The macerating means projecting upwardly of

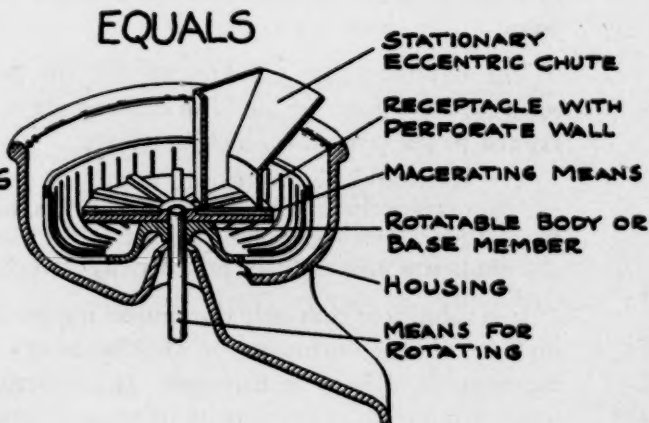
BROPHY
1,454,918



STEERE
1,349,739



WHAT
DRACHENBERG
CLAIMS



the base comprises the disk and ribs of Steere which rotate across the lower end of the Steere chute to engage and macerate material and carry it clear of the chute and project it toward the wall of the receptacle.

Any other claim at issue may be similarly applied, there being no real difference between the claims so far as the claimed subject matter is concerned.

In the case of *Cuno Engineering Corp. vs. Automatic Devices Corp.*, 314 U.S. 84, this Court said:

"More must be done than to utilize the skill of the art in bringing old tools into new combinations . . . Tested by that principle Mead's device was not patentable . . . He merely incorporated the well-known thermostat into the old 'wireless' lighter to produce a more efficient, useful, and convenient article."

POINT IV

There is no logic in Respondent's position that Drachenberg succeeded where others failed unless the claims in issue include the structure upon which his success is based.

The Circuit Court of Appeals for the Sixth Circuit seems to have gone far afield in making the assertion with regard to the prior art machines that:

"It would be impossible in any of these machines to extract the juice from apples, pears, beets, carrots, or from leafy material such as spinach, all of which ends are successfully attained by Drachenberg."

It is submitted that only the subject matter of the claims and not the performance of Drachenberg's commercial machines is at issue in this case. It has been shown that apart from such conventional items as a housing, a base and a motor, the claims call only for a macerating device

fed by an off-center chute which serves to free the juice, and a centrifugal strainer for separating the juice from the pulp. If Drachenberg had refinements in his macerating device or his strainer to enable him to operate on particular materials, he failed to include these in his claims and chose to direct his claims broadly to the old combination of a macerating device and a strainer. The word "macerate" comes from a Latin root meaning to make soft. Its dictionary definition is to soften and wear away. Such is the precise function of the ribs M of Steere and the reamer 6 of Brophy and the grinding plate 36 of Jenkins (not to mention the "cutting edges of the collar I" of Naylor 528,735 "whereby the feed is so reduced as to pass into the bowl)."

If Drachenberg's broadly claimed "macerating means" is better adapted to get juice out of vegetables than is the macerating means in the art of record, Drachenberg failed to include in his claims any of the structure responsible for the alleged improved result.

In the Case of *Toledo Pressed Steel Co. vs. Standard Parts, Inc.*, 307 U.S. 350, this Court said:

"And similarly without significance on the question of novelty is the fact that, as Plaintiff claims, utility resulted and commercial success followed from what patentees did."

The foregoing quotation applies with increased significance to a case where, as in the present, the alleged success is based on subject matter wholly irrelevant to what was claimed.

POINT V

The old combination to which the claims at issue are directed cannot be repatented merely because Respondent claims to have improved one of the elements.

Steere 1,349,739 and Jenkins 1,953,794 both show the entire combination of a housing, a motor, a base, a chute, a macerating means and a strainer which receives the pulp and juice.

The difference between the claimed subject matter and the device of Steere resides solely in the fact that the strainer of the Drachenberg device is rotative.

The difference between the subject matter of the claims at issue and the prior art device of Jenkins resides solely in the fact that the Drachenberg chute has the form of a segment rather than a complete circle, whereby its outlet is located eccentrically above the macerating means.

Since none of the elements is cooperative in any new sense by reason of any change imparted thereto by Drachenberg, the invention of Drachenberg, if any, resided in the individual elements which he changed. He could not make a new combination by changing a single element and leaving it in an old combination to perform in an old and well known way. If he contends that the centrifugal strainer was his invention, he should have claimed the centrifugal strainer as such. If he contends that he invented an off-set chute, his claims should have been phrased accordingly. Instead, he has chosen to present a claim to an old combination in which all of the elements are old and in which each performs the same function which it performed in the prior art.

In *Bassick Mfg. Co. vs. R. M. Hollingshead Co.*, 298 U.S. 415, this Court held that the patentee could not

"by improving one element of an old combination whose construction and operation is otherwise unchanged . . . in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element."

In the present case, Drachenberg has not even contributed as much as the patentee in the Bassick case, for the claims do not include any improved element but merely attempt to repatent old combinations by substituting in them old elements which perform the same functions they have been used to perform in the prior art.

As this Court said in *Lincoln Engineering Company vs. Stewart-Warner Corporation*, 303 U.S. 545:

"The mere aggregation of a number of old parts or elements, which, in the aggregation perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable invention, and the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination."

Therefore, in sustaining the claims at issue, the Court of Appeals for the Sixth Circuit has rendered a decision which is untenable because in direct conflict with the applicable decisions of this Court.

CONCLUSION

Grant of the Writ of Certiorari in accordance with the Petition is therefore prayed to the end that the decision of the Sixth Circuit Court of Appeals finding valid Drachenberg patent 2,273,093 may be reviewed and reversed.

Respectfully,

WILL FREEMAN,
S. L. WHEELER,

Counsel for Petitioner.

Dated: Milwaukee, Wisconsin
March 9, 1946.